UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,001	09/07/2000	Erez Halahmi	G01/4	1829

7590   11/28/2003

Dr. D Graeser LTD
c/o The polkinghorns
9003 Florin Way
Upper Marlboro, MD 20772

EXAMINER
MAURO JR, THOMAS J

ART UNIT	PAPER NUMBER
2143	3

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	09/657,001	HALAHMI ET AL.
	Examiner	**Art Unit**
	Thomas J. Mauro Jr.	2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 September 2000</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-18</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-18</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>07 September 2000</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a)☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5)☐ Notice of Informal Patent Application (PTO-152)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> .   6)☐ Other: .

DETAILED ACTION

1.   Claims 1-18 are pending. A formal action on the merits of claims 1-18 follows.

Drawings

2.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they

do not include the following reference sign(s) mentioned in the description: Figure 1 does not

have a lead line for item 10 (system) as described on page 7 line 23 of the specification. A

proposed drawing correction or corrected drawings are required in reply to the Office action to

avoid abandonment of the application. The objection to the drawings will not be held in

abeyance.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who
> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
> thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

4.   Claims 1-6, 8, 11-15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by

Pollack (U.S. 6,505,236).

With respect to claim 1, Pollack teaches selectively downloading a multi-part e-mail

message to an e-mail client operated by a user from an e-mail server **[Pollack -- Abstract]**, the

multi-part e-mail message including an attachment, the steps of:

a.   Retrieving at least attachment information for the multi-part e-mail message from

the e-mail server **[Pollack -- Col. 5 lines 17-19 – Handle generator receives file name**

and location, i.e. attachment information, of attachment];

b.   Preparing a formatted message for sending to the e-mail client, said formatted

message containing a link to the attachment, such that the attachment is not sent to the e-

mail client **[Pollack -- Figure 2 items 104 and 112 and Col 5 lines 19-22 and 30-32 –**

Formatted message containing link is created without attachment];

c.   Sending said formatted message to the e-mail client **[Pollack -- Figure 2 item**

112 and Col. 5 lines 30-32 – Formatted message is sent without attachment to user];

and

d.   Displaying said formatted message to the user by the e-mail client **[Pollack --**

Col. 4 lines 44-45 – User downloads message to view on his device].

With respect to claim 2, Pollack further teaches wherein said attachment information includes the entirety of the multi-part e-mail message, such that step (b) further comprises the step of separating the multi-part e-mail message into a plurality of portions, including at least a first portion containing the attachment **[Pollack -- Figure 2 and Col. 4 lines 25-29 -- Entire mail message is retrieved from server upon which it is parsed, extracting the attachment from the message]**.

With respect to claim 3, Pollack further teaches wherein the multi-part e-mail message includes a text-part, such that step (b) further comprises the step of separating the multi-part e-mail message into a second portion containing said text-part **[Pollack -- Col. 1 lines 59-67 and Col. 4 lines 25-29 -- After attachment is detached, the body of the e-mail, i.e. text, remains]**, and wherein step (b) includes the step of adding said second portion to said formatted message **[Pollack -- Col. 5 lines 28-32 -- Appended mail item includes handle, i.e. link to attachment, and text/body of original mail message]**.

With respect to claim 4, Pollack further teaches the step of:

    e.   selecting said link by the user from said formatted message **[Pollack -- Col. 5 lines 47-50 -- Once downloaded, user can choose to download attachment by clicking on the handle, i.e. link]**.

With respect to claim 5, Pollack further teaches the step of:

f.   downloading said attachment in a streamed manner for viewing by the

user **[Pollack -- Col. 5 lines 61-67 – Attachment can be downloaded in a

streaming format to user]**.

With respect to claim 6, Pollack further teaches the steps of:

g.   providing a Web browser for interacting with the user **[Pollack -- Col. 5

lines 56-59 – User accesses attachment retriever via web browser]**; and

h.   displaying said attachment by said Web browser, such that step (f) is

performed according to HTTP **[Pollack -- Col. 56-67 – Attachment is downloaded

using browser, inherently using the well-known and widely used HTTP and HTML

services, to access server and retrieve/view attachment in browser window]**.

With respect to claim 8, Pollack further teaches wherein said attachment information is a

header for the attachment **[Pollack -- Col. 5 lines 17-19 – Attachment information, such as

filename, inherently comes from the header of the file, i.e. attachment]**, such that the method

further comprises the step of:

i.   downloading the attachment from the e-mail server **[Pollack -- Figure 1

(receiving portal), Figure 2 and Col. 4 lines 5-8 – Mail storage system receives e-mail

message from e-mail server along with the attachment]**.

With respect to claim 11, Pollack further teaches the steps of:

j.   selecting said link by the user from said formatted message [Pollack --

Figures 2 and 3 and Col. 5 lines 47-50 – After downloading appended message, user selects

handle, i.e. link];

k.   downloading the attachment from the e-mail server [Pollack -- **Figure 1**

(receiving portal), Figure 2 and Col. 4 lines 5-8 – Mail storage system receives e-mail

message from e-mail server along with the attachment]; and

l.   downloading said attachment from proxy to client in a streamed manner

for viewing by the user [Pollack -- **Col. 5 lines 61-67 – Attachment can be downloaded in a**

streaming format to user from the system/server acting as an intermediary storing the

attachment].

With respect to claim 12, this claim is similar to claim 6. Therefore, because they are

similar, claim 12 is rejected under the same rationale as claim 6.

With respect to claim 13, Pollack further teaches wherein step (a) includes the step of

providing an e-mail proxy for communicating with the e-mail server and with the e-mail client,

such that steps (a) – (c) are performed by said e-mail proxy [Pollack -- **Figure 1 and Col. 4 lines**

3-7 – Intermediary system, i.e. proxy, contains receiving portal for receiving the message

and storing the attachment along with transmitting portal for sending the appended

message to the client without the attachment].

Application/Control Number: 09/657,001 — Page 7

With respect to claim 14, Pollack teaches a system for selectively downloading a multi-part e-mail message for a user, the multi-part e-mail message including an attachment, the system comprising:

a.   An e-mail server for receiving the multi-part e-mail message [**Pollack -- Figure 1 (receiving portal) and Col. 4 lines 3-7**];

b.   An e-mail proxy in communication with said e-mail server for receiving at least attachment information about the multi-part e-mail message, and for preparing a formatted message containing a link to the attachment [**Pollack -- Col. 4 lies 27-29 and Col. 5 lines 30-32 – Proxy, generates handle information, i.e. link, from attachment information and formats message to include e-mail body and handle, i.e. link**]; and

c.   An e-mail client in communication with said e-mail proxy for receiving said formatted message and for displaying said formatted message to the user, such that the attachment is displayed to the user after the user selects said link [**Pollack -- Col 5 lines 47-50 – User downloads message using e-mail client, views appended message, and can view attachment by clicking on link**].

With respect to claim 15, Pollack further teaches wherein said e-mail proxy downloads the attachment with said attachment information [**Pollack -- Col. 4 lines 3-7 – Attachment is downloaded, which is used to get information, i.e. from header, to append to e-mail message as handle, i.e. link**].

With respect to claim 17, Pollack further teaches wherein the multi-part e-mail message

contains a text-part, and said formatted message includes said text-part [**Pollack -- Col. 1 lines**

59-62 and Col. 5 lines 30-32 -- Appended message contains handle and e-mail body without

attachment].

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollack

(U.S. 6,505,236), as applied in claim 5 above, in view of Pizano et al. (U.S. 6,105,055).

Regarding claim 7, Pollack teaches the invention substantially as claimed, but fails to

teach wherein the attachment is decoded before being downloaded.

Pizano, however, teaches a delayed conference manager which downloads the e-mail and

decodes any attachments before transferring the message/attachments to the user [**Pizano -- Col.**

4 lines 46-47].

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to incorporate the decoding of mail items, i.e. e-mail and attachments, as taught by Pizano into

the invention of Pollack, in order to ensure that the user will be able to view the attachment by

having the server decode it rather than relying on each machine hopefully having the ability to

decode the attachment.

Regarding claim 10, Pollack-Pizano teach the invention substantially as claimed, wherein

step (e) includes the step of decoding said attachment **[Pollack -- Col. 5 lines 47-50 – Decoding**

occurs once user requests attachment, which occurs by selecting the handle, i.e. link, in the

message].

7.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pollack, as applied

to claim 8 above, in view of Dowling et al. (U.S. 6,574,239).

Regarding claim 9, Pollack teaches the invention substantially as claimed, as

aforementioned in claims 1 and 8 above, but fails to teach wherein step (i) is performed in

parallel to step (b).

Dowling, however, teaches background downloading of data that will not be used until later

while other processes are occurring **[Dowling -- Col. 16 lines 9-12]**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to incorporate the parallel, i.e. background, downloading of data files, i.e. attachments, as taught

by Dowling into the invention of Pollack, in order to allow a user or system to continue to

process other instructions instead of waiting for another, non-critical, process to finish.

8.   Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pollack (U.S.

6,505,236), as applied above in claim 14, in view of Slotznick (U.S. 6,011,537).

        Regarding claim 16, Pollack teaches the invention substantially as claimed, but fails to

teach downloading the attachment separately from said attachment information.

Slotznick, however, teaches of downloading primary and secondary information containing

information about a file before downloading the actual full file **[Slotznick -- Col. 26 lines 62-67**

– Col. 27 lines 1-5].

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to incorporate the downloading of file information before the actual file, as taught by Slotznick

into the invention of Pollack, in order to reduce the wait time required by one process to continue

running by downloading only the portion of information that process needs first.

9.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pollack (U.S.

6,505,236), as applied to claim 14 above, in view of Pizano et al. (U.S. 6,105,055).

        Regarding claim 18, Pollack teaches the invention substantially as claimed, but fails to

teach wherein the e-mail proxy downloads and decodes the attachment before it is sent to the e-

mail client.

Pizano, however, teaches this limitation substantially as claimed, wherein the e-mail proxy

downloads and decodes the attachment before it is sent to the e-mail client [**Pizano — Col. 4**

lines 46-47].

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to incorporate the decoding of mail items, i.e. e-mail and attachments, as taught by Pizano into

the invention of Pollack, in order to ensure that the user will be able to view the attachment by

having the server decode it rather than relying on each machine hopefully having the ability to

decode the attachment.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

- Kuzma (U.S. 5,781,901) discloses a method for attaching an e-mail attachment by

    reference, i.e. link, rather than by value.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 703-605-1234.

The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the

organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-3900.

TJM

November 21, 2003

BUNJOB JAROENCHONWANIT

PRIMARY EXAMINER